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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Scott C. Harris

Appl. No. : 09/690,002

Filed : October 16, 2000

For : AUTOMATIC MAIL
REJECTION FEATURE

Examiner : Jerry Dennison

Group Art Unit: 2142

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Scott C. Harris

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6/18/07

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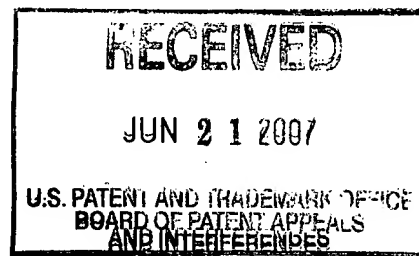
Reply Brief

Sir:

Applicant herewith files this reply brief, responding only to the new points of argument.

Initially, it is respectfully suggested that many of the items raised in this reply brief are wholly improper to be raised for the first time only after an appeal brief has been filed, and prosecution is closed. Many new grounds of rejection, new prior art, and new claim rejections were raised in an Examiner's answer, for the first time. Each of these items are wholly improper to be raised at this point. Multiple requests for reconsideration were filed throughout prosecution, the patent office did not see fit any of

those times to raise these issues. Only after appeal, and an appeal brief is actually filed, did the patent office raise these issues.

This in itself is wholly improper. Applicant believes that it is improper for:

1) new claims to be rejected in the examiner's answer that were not rejected at the time of appeal,

2) new art to be cited in the examiner's answer, without the opportunity to put this art onto a PTO-892, and without the opportunity, in essence, for applicant to respond to this art, and

3), a wholly new theory of claim construction to be rendered.

While it might be proper for the examiner to do item 3 (albeit unfair), it is certainly not proper for 1 and 2 to have been done in an examiner's answer.

On page 2 of the reply brief, new reply brief contends that the examiner "inadvertently left out claims 15 and 16 in the preamble of the rejection". Failure to reject a claim means that the patent office has not met their prima facie burden of showing a prima facie showing of unpatentability. Accordingly, failure to reject the claim does not meet the Patent Office's burden under 35 USC 102. Attempting to say that this an "oversight" simply flies in the face of the administrative procedure. If there was a mistake in the rejection, then the rejection should be redone to correct the mistake. One cannot simply say that failure to reject a claim was somehow an inadvertent action.

Second, on page 11 of the reply brief, the patent office, for the first time, responds to our request that a reference be cited. In response to requesting these references, the patent office now cites three separate references, without making them of record. This is wholly improper under the PTO's own rules.

New Rejections/ Points of Argument

The first new point of Argument is set forth on page 7, where for the first time, the rejection contends that the prior art could be used with any e-mail program, and therefore it is "inherent that" the user is provided with a conventional delete button *in addition to* the delete button provided by the prior art. This was never stated during prosecution. In fact, this goes against conventional wisdom. Since the prior art already had a delete button, one would not expect to duplicate the effort and provide an additional delete button. The only place where the teaching for these two separate delete buttons is found is in applicant's specification and claims. This is not found in the prior art, and in fact is a classic hindsight reconstruction of the prior art.

Moreover, there is no teaching or suggestion in the prior art that it could be used with a different kind of e-mail program. The rejection attempts to read much into the fact that we admit that a conventional e-mail program has a delete button. Of course it does: this does not mean, however, that a conventional e-mail program has two delete buttons that indicate two different functions or has three delete buttons that indicate three different functions. The rejection would have us accept the unconventional and anti-commonsense notion that the Horvitz prior art, which itself teaches the use of a delete button, would be used with another e-mail program that has its own delete button. This does not explain why one would DUPLICATE THIS FUNCTIONALITY. The motivation to do this comes from the teaching of the present application, not from the prior art. This is quite simply against any notion of common sense, not taught by the references, and based on hindsight.

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The next new point of argument, is an analogous argument for Pang. The fact that this <u>could</u> be used with typical e-mail client applications does not mean that one would have combined it in a way to use multiple different delete buttons. Quite simply, no one in the prior art ever considered, taught, or suggested the possibility of using multiple delete buttons in this way. The contention that because there is one delete button, that someone would combine this with another delete button, defies logic.

Moreover, even if some were one were to combine it in this way, it would simply be a Pang type delete button combined with a conventional delete button. An analogous argument was raised on page 12.

Applicants have no further comments regarding the section 101 rejection. It is respectfully suggested that this rejection is incorrect.

From page 17 on, the examiner for the first time, points out a wholly new claim interpretation, indicating that the claims did not disclose who is doing the indicating, what is being indicated or how communications are used. This rejection is purported to be based on the well-known canon in patent law, that an examiner can take the broadest reasonable interpretation of a claim. It is believed wholly improper to raise this issue only after an appeal brief has been filed, and this is tantamount to a new ground of rejection.

In any case, applicant respectfully suggests that this is not the broadest *reasonable* interpretation, but rather a very broad UNREASONABLE interpretation of these claims. The rejection states that the claim language, specifically, using the language of claim 1, "displaying information about the electronic mail message in a way that allows all of deleting the message without indicating whether it is spam or not,

deleting the message while indicating that it is spam, or deleting the message while indicating that it is not spam" could somehow be done by a single button. This interpretation defies logic. How could three different actions be done and "indicated" by one delete button as claimed? The undersigned knows of no delete button that could carry out three separate indicating actions as claimed.

This unreasonable interpretation attempts to read the word "indicating" out of claim 1. Claim 1 requires

1) deleting the message *without indicating whether* it is spam or not,

2) deleting the message *while indicating that it is* spam, or

3) deleting the message *while indicating that it is* not spam.

A single delete button might be able to delete a message that is spam, is not spam, or you're not sure that is spam or not spam. However, it could not indicate all three of those things. Since it is only a single button, it could only indicate <u>one thing</u>. Since the interpretation taken by this rejection attempts to read the word "indicating" out of the claim (or tries to somehow read a user's thoughts while using the button into part of the claim), it attempts to read the claim as though the term "indicating" has absolutely no meaning and no limitation. As such, this is not a reasonable interpretation of the claim.

In fact, the only way that a single delete button could do all three of these things is to do it without indicating, and hence ignore the claim limitation.

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In a similar way, claim 14, has a plurality of controls. How could a claimed plurality of controls read on a single delete button, as is now taken as the so-called "broadest reasonable interpretation"?

In addition, claim 14 requires that these controls delete while indicating that the e-mail is spam, or indicating that e-mail is not spam. A single delete button does not satisfy the functionality for both of these. The interpretation, and the examiner's answer that "a person can indicate to a friend sitting next to him or her that this is not spam" is wholly unreasonable, not a 'reasonable interpretation'.

Claim 23 defines a method, which again requires indicating. The user interface must allow the selection of doing all these things while indicating. The unreasonable interpretation taken by the claims were taken by the rejection is respectfully suggested to be incorrect.

The citation of MPEP 2111 makes the point exactly. The claims must be interpreted as broad as their terms reasonably allow. The unreasonable interpretation taken here, that requires actions in the mind of some actor that is not part of the claim, is not in any sense reasonable. With all due respect, this attempts to read limitations out of the claim. It attempts to read the claim in such a broad way as to make the words have absolutely no meaning at all.
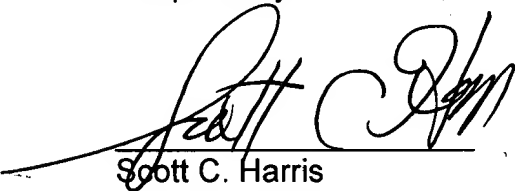
Claims must be given their broadest reasonable interpretation, but at some point, one must be able to rely on the words meaning something.

Moreover, since these references are only now cited after appeal, are not listed on any 892, they are not properly of record in the case. It is wholly improper for this tribunal to rely on those references in any way. Should the examiner really desire to rely on these

references, than it is respectfully suggest that the examiner must follow the patent

office's own rules.

Respectfully submitted,

Date: 6/18/07

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